IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant | : Conroy et al. | Art Unit | : 1651 |
| Serial No. | : 09/785,188 | Examiner | : David Naff |
| Filed | : Feb. 20, 2001 | | |
| Title | : SOL-GEL BIOMATERIAL IMMOBILIZATION | | |



Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

In response to the requirement for restriction mailed July 1, 2002, applicants provisionally elect groupII, claims 15-26 and 28-36 for further prosecution should the requirement for restriction be made final.

The requirement for restriction is respectfully traversed on three grounds.

Firstly, 35 U.S.C. §121 reads,

> "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions."

Thus, restriction is proper only if the inventions are "independent and distinct." MPEP §802.01 reads:

> **INDEPENDENT**
> The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.
>
> **DISTINCT**
> The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

Since the requirement for restriction has not shown that the claims in groups I and II "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER," applicants respectfully request that the requirement be withdrawn.

Secondly, MPEP §816 states:

> "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given."

In regard to groups I and II, the requirement for restriction asserts:

> "The methods and products of inventions I and II are mutually exclusive due to the presence of an organic solvent in invention I and the absence of an organic solvent in invention II."

However, Claim 1 of group I recites "removing said organic solvent from said hydrolyzed sol," clearly contradicting the particular reasons relied on by the examiner for holding that the inventions are distinct. Applicanttherefore respectfully requests that the requirement for restriction between groups I and II be withdrawn or, at a minimum, that a new office action, concisely stating the particular reasons for holding groups I and II distinct, be issued.

Thirdly, MPEP §803 directs,

> "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

Manifestly, there is no serious burden to examine all the claims, especially since claims in the different groups have elements in common for which the examiner must search when examining the claims in each group. Still further, each of the claims is relatively short and easy to examine.

In light of the above arguments, applicants respectfully request reconsideration and withdrawal of the requirement for restriction.

Respectfully submitted,

Date: 7/26/02

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